

REMARKS

I. Introduction

Claims 1, 4, 5, 7 to 19, 24, 25, 29 to 37, 39, 40, and 70 to 84 are now pending in the above-referenced application and are submitted for the Examiner's reconsideration. Applicants note with appreciation the indication that claims 5, 7 to 9, 11 and 13 have been allowed, and that claim 10 includes allowable subject matter. In this regard, it is respectfully submitted that claim 10 is believed to be in condition for immediate allowance since it is already in independent form and since it was previously allowed as indicated, for example, on page 3 of the Office Action of December 13, 2002, and in the Office Action Summary associated therewith.

II. Rejection of Claims 12, 13 and 84 under 35 U.S.C. § 101

Claims 12, 13 and 84 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In view of the amendments made to claims 12, 13 and 84, it is respectfully submitted that this rejection has been obviated.

III. Rejection of Claims 15-18 under 35 U.S.C. § 112

Claims 15 to 18 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicants regard as the invention. In view of the amendments made to claims 15 to 18, it is respectfully submitted that this rejection has been obviated.

IV. Rejection of Claims 1, 19, 24, 29, 32, 35, 39, 49 and 70-84 under 35 U.S.C. § 102(b)

Claims 1, 19, 24, 25, 29, 32, 35, 39, 40 and 70 to 84 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,407,296 ("Anderson"). Applicants respectfully submit that these claims as presented are patentable for at least the following reasons.

Claim 1 as presented relates to an apparatus for fixation of a sensor in a bodily lumen, which includes a non-inflatable fixation device configured to expand circumferentially within the bodily lumen. Support for these features of claim 1 is found at least in Figures 2, 3 and the related text of the Specification.

In order for a reference to anticipate a claim, "every element of the claimed invention must be identically shown in a single reference." In re Bond, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) (emphasis added). Applicants respectfully submit that Anderson does not identically show every limitation recited in amended claim 1 because Anderson does not show an expandable fixation device. The only element of the Anderson that can reasonably be viewed, for the sake of argument only, as a fixation device are tines 50a, which are not described as expandable. Indeed, Figures 1 and 11 merely show the tines 50a as a series of sharp projecting points. It is therefore respectfully submitted that Anderson does not identically teach an expandable fixation device, as recited in amended claim 1. Accordingly, the rejection of claim 1 as anticipated by Anderson should be withdrawn.

With respect to claims 19, 24, 25, 32, 35, and 70 to 84, Applicants submit that these claims as presented are patentable for at least the same reasons given in support of the patentability of claim 1, and therefore the rejection of claims 19, 24, 25, 32, 35 and 70 to 84 as anticipated by Anderson should be withdrawn.

With respect to claims 39 and 40, Applicants submit that these claims are not anticipated for at least the reasons that Anderson does not identically disclose every element of these claims. In particular, Anderson does not identically disclose coupling a sensor to a section of a bodily lumen using sutures or adhesive, as recited in claims 39 and 40 respectfully. Accordingly, the rejection of claims 29 and 40 as anticipated by Anderson should be withdrawn.

V. Rejection of Claims 1, 11, 24, 25, 29, 32, 35-37, 70-80 and 82 under 35 U.S.C. § 102(b)

Claims 1, 11, 24, 25, 29, 32, 35 to 37, 70 to 80 and 82 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,048,532 ("Hickey"). Applicants respectfully submit that Hickey does not identically show every limitation recited in amended claim 1 because Hickey does not show a non-inflatable fixation device configured to expand circumferentially within the bodily lumen. Instead, Hickey purports to show a method and apparatus for measuring left atrial pressure by inserting a balloon-containing sensor probe 40 into the esophagus 48 and positioning the probe 40 so that when the balloon(s) 46 are inflated, pressure from the left atrium is determined by the effect of the atrial pressure upon the balloon(s) 46. See Hickey, col. 3, lines 39 to 42, Figures 4, 6 and related text. In this regard, the balloon-containing sensor probe 40 includes an isovolumetric balloon-containing

catheter 20, a counter-pressure balloon-containing catheter 10, and a positioning balloon-containing catheter 41, in which the catheters 10 and 20 combine to form the sensing catheter and the positioning catheter 41 includes an inflatable positioning balloon 42 to position the sensing catheter, so that once positioned, the sensing balloons 46 of the sensing catheter may be filled and the mean left atrial pressure measured. See Hickey, col. 7, lines 47 to 54, col. 9, lines 30 to 37. In other words, to position and secure the balloon-containing catheters the balloons must be inflated, and any external device intended to fix the catheters in place cannot be configured to expand circumferentially within a bodily lumen. It is therefore respectfully submitted that Hickey does not identically teach every limitation recited in claim 1. Accordingly, the rejection of claim 1 as being anticipated by Hickey should be withdrawn.

With respect to claims 11, 12, 24, 25, 29, 32, 35 to 37, 70 to 80 and 82, Applicants submit that these claims are patentable for at least the same reasons given in support of the patentability of claim 1. Accordingly, it is respectfully submitted that the rejection of claims 11, 12, 24, 29, 35 to 37, 70 to 80 and 82 as being anticipated by Hickey be withdrawn.

VI. Rejection of Claims 15-18, 30 and 31 under 35 U.S.C. § 103(a)

Claims 15 to 18, 30 and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson. Claims 15 to 18 have been amended to recite limitations analogous to claim 1. Claims 30 and 31 ultimately depend from claim 24, which has also been amended to recite limitations analogous to claim 1. Applicants therefore respectfully submit that these claims as presented are patentable for at least the same reasons given in support of the patentability of claim 1. Accordingly, it is respectfully submitted that the rejection of claims 15 to 18, 30 and 31 as unpatentable over Anderson be withdrawn.

CONCLUSION

The present invention is new, non-obvious, and useful. Reconsideration and allowance of the claims are respectfully requested.

Respectfully submitted,

KENYON & KENYON

Dated: October 1, 2004

By: Michael P. Paul
Michael P. Paul
(Reg. No. 53,443)

One Broadway
New York, NY 10004
(212) 425-7200